

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte AKIHIRO SUMIKAWA

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Appeal No. 96-1842  
Application 08/193,356<sup>1</sup>

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ON BRIEF

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Before KRASS, JERRY SMITH and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134

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<sup>1</sup> Application for patent filed February 3, 1994. According to appellant, this application is a continuation of Application 07/896,887, filed June 10, 1992, now abandoned; which is a continuation of Application 07/595,802, filed October 10, 1990, now abandoned.

from the examiner's rejection of claims 1-11, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for controlling the display of plural windows on a display apparatus. Specifically, the position of a second window is maintained at a constant distance from a movable point on the display.

Representative claim 1 is reproduced as follows:

1. A display apparatus comprising:

a display;

means for displaying a first window containing first information and a second window containing second information on the display;

cursor means for indicating a first point on the display;

means for positioning said second window on said display at a selected horizontal distance and a selected vertical distance from said first point, said second window being movable with said first point while maintaining said selected horizontal and vertical distances from said first point when said first point is moved to other positions on the display, said second window excluding the first point.

The examiner relies on the following references:

Berry et al. (Berry)	4,789,962	Dec. 6, 1988
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Kinata et al. (Kinata), Working With Word, Second Edition, Published by Microsoft Press, 1988, pages 360-363.

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Claims 1-11 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers either Kinata or Berry taken alone.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answers for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-11. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is

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incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992).

As indicated by the cases just cited, the examiner has at least two responsibilities in setting forth a rejection under

35 U.S.C. § 103. First, the examiner must identify all the differences between the claimed invention and the teachings of the prior art. Second, the examiner must explain why the identified differences would have been the result of an obvious modification of the prior art. In our view, the examiner has not properly addressed his first responsibility so that it is impossible that he has successfully fulfilled his second responsibility.

Each of independent claims 1, 5 and 9 recites that a second window is movable in concert with a point on a display while maintaining a selected horizontal and vertical distance between the second window and the point, and the second window excluding the point.

With respect to Kinata, the examiner considers the "Metals-Space Between" window to be the first claimed window and Table 9-1 to be the second window [answer, page 3]. The insertion point of the word processing program is considered

by the examiner to be the claimed first point [id., pages 7-8]. The examiner maintains that Table 9-1 in Kinata is always maintained the same distance from the insertion point.

Appellant argues that Table 9-1 in Kinata would not follow both horizontal and vertical movement of the insertion point [brief, page 9]. The examiner responds that the claims do not require movement of the second window in both the horizontal and the vertical direction [answer, pages 8-9].

We agree with appellant that the examiner has misconstrued both the scope of the claim and the teachings of Kinata. As noted above, each of the independent claims recites that both the horizontal and vertical distances are maintained between the second window and the selected point on the display. Kinata simply does not teach or suggest this feature. Whether the selected point in Kinata is deemed to be the "I-bar" or the insertion point as asserted by the examiner, the second "window" of Kinata (Table 9-1) does not move in horizontal and vertical step with the selected point. While portions of Table 9-1 may move in response to movement of the insertion point, the movement is not required to maintain horizontal and vertical distances as recited in the

independent claims.

Since the examiner has failed to properly identify the differences between the invention of the independent claims and Kinata, the examiner has provided no analysis as to why these differences would have been obvious to the artisan in view of the prior art. Therefore, the examiner has failed to establish a prima facie case of the obviousness of independent claims 1, 5 and 9. Accordingly, the rejection of claims 1-11 as unpatentable over the teachings of Kinata is not sustained.

With respect to Berry, the examiner considers the primary window to be the first claimed window and the help window to be the second window [answer, page 5]. The cursor selection point of the display is considered by the examiner to be the claimed first point [id.]. The examiner maintains that the help window in Berry is always maintained the same distance from the cursor selection point. Appellant argues that Berry provides no disclosure regarding holding the vertical and horizontal distance between the cursor 20 and the help window constant when the cursor 20 is moved as required by the independent claims [brief, page 10]. The examiner

responds that the distance from the cursor 20 to the side of the help window does not change when the cursor 20 is moved in Berry [answer, page 9].

We again agree with appellant that the examiner has misconstrued both the scope of the claims and the teachings of Berry. We again observe that each of the independent claims recites that both the horizontal and vertical distances are maintained between the second window and the selected point on the display. Berry simply does not teach or suggest this feature. The help window of Berry does not move in horizontal and vertical step with the selected point. While the help window

may move in response to movement of the insertion point, the movement is not required to maintain horizontal and vertical distances as recited in the independent claims.

Since the examiner has again failed to properly identify the differences between the invention of the independent claims and Berry, the examiner has provided no analysis as to why these differences would have been obvious to the artisan in view of the prior art. Therefore, the examiner has failed to establish a prima facie case of the



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obviousness of independent claims 1, 5 and 9. Accordingly,  
the rejection of claims 1-11 as unpatentable over the  
teachings of Berry is not sustained.

In conclusion, we have not sustained either of the  
examiner's rejections of the claims. Therefore, the decision  
of the examiner rejecting claims 1-11 is reversed.

REVERSED

	ERROL A. KRASS	)	
	Administrative Patent Judge	)	
		)	
		)	
	JERRY SMITH	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	LEE E. BARRETT	)	
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